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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/781,698

02/13/2001

Lester Sussman

1433

63597

7590

04/30/2007

LESTER SUSSMAN

9213 BULLS RUN PARKWAY

BETHESDA, MD 20817-2403

EXAMINER

SHAAWAT, MUSSA A

ART UNIT

PAPER NUMBER

3627

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/781,698	SUSSMAN, LESTER	
	<b>Examiner</b>	<b>Art Unit</b>	
	Mussa A. Shaawat	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 14-20 and 34-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-20 and 34-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Response to Amendment***

1. This action is in response to amendment filed on March 27/2007. Applicant elected claims 14-20. Claims 14 and 18 have been amended. Claims 1-13 and 21-33 have been cancelled. Claims 34-44 are newly added. Claims 14-20 and 34-44 are pending examination.

2. Applicant's election of group 14-20 in the reply filed on 3/27/2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 14-20 and 34-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 14-20 and 34-44 are rendered indefinite by the use of both method and apparatus language. Applicant claims a method in the preamble of claim 1, but the body of the claim is directed towards components of an apparatus. .

5. In addition Claims 16 and 38 are rendered indefinite by the use of the trademarked term BLUETOOTH, and by reference to the "Bluetooth radio frequency standard." MPEP § 608.01(v) states, "the examiner should hold the disclosure insufficient and reject on the ground of insufficient disclosure any claims based on the

identification of the product merely by trademark or by the name used in trade.” Furthermore, the “Bluetooth radio frequency standard” is indefinite, because such a standard may be subject to change over time.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14-15, 17-19, 34-37, 39-41 and 43-44 rejected under 35 U.S.C. 102(b) as being anticipated by Ruppert et al US Patent No. (5,424,524) referred to here in after as Ruppert.

As per claim 14, Ruppert a method for creating a consumer's shopping list prior to entering a store, comprising:

(a) A portable barcode scanner, comprising: a processor (see fig.3, block 40); a memory that stores product information under the control of the *said* processor (see fig.3, blocks 43, and 48); logic that obtains a product barcode (fig.3 block 46); logic that obtains a product coupon barcode (fig.8 block 140); logic that indicates that said product barcode or said product coupon barcode has been scanned and stored in said memory (fig. 1 blocks 24, 36); logic that indicates the number of said product barcodes and said product coupon barcodes stored in said memory (fig.1 block 24); logic that indicates said memory is full (an obvious feature to any processor); logic that creates a query based on said product barcode or said product coupon barcode (fig.5 block 56); logic

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that transmits said product barcode or said product coupon barcode to one or more first computers over a first network infrastructure (fig.5 block 108); logic that indicates that said product barcode or said product coupon barcode has been transmitted to one or more first computers over said first network infrastructure (see col.8 lines 50-53); logic that receives said product barcode or said product coupon barcode associated information from one or more first computers over said first network infrastructure (fig.8 block 140); logic that displays said product barcode or said product coupon barcode associated information on a display, received from one or more first computers over said first network infrastructure (fig.1, display); wherein said product barcode associated information relates to at least one of product description, product cost, date and time on which said product barcode was scanned, and a required quantity of said product (fig.1 block 24); and wherein said product coupon barcode associated information relates to at least one of product description, product cost, date and time on which said product coupon barcode was scanned, and a required quantity of said product (see at least fig. 1 block 24, abstract, coupons are matched and discounted);

(b) One or more first computers, each first computer comprising; an associated communications interface channel to receive data from, and to transmit data to, said portable barcode scanner over said first network infrastructure (fig.3 block 85); logic that stores said data as shopping list information under the control of said product barcode or said product coupon barcode, in a memory means (fig.5 block 192); logic that communicates with a second computer system, over a second network infrastructure to request and receive said product associated information based on said product barcode

or said product coupon barcode (fig.6 block 110); logic that keeps track of the frequency that said product barcode or said product coupon barcode has been received from said barcode scanner over said first network infrastructure (see col.8 lines 50-53); logic that provides notification of repetitively scanned said product barcodes or said product coupon barcodes (see col.2 lines 43-53); logic that displays a multiplicity of product barcodes or said product coupon barcodes, together with said product associated information, on a first computer display (see fig. 1 display); and logic that indicates that said consumer has obtained said shopping list information in-hand (see fig.1 shows handheld device with shopping list);

(c) Scanning a needed product barcode or a needed product coupon barcode using said portable barcode scanner (see col.5 lines 48-60, fig. 1);

(d) Transferring said scanned product barcode or said product coupon barcode to said first computer, over said first network infrastructure (see col.6 lines 1-18, fig. 5 108);

(e) Storing said transferred product barcode or said product coupon barcode in a shopping list database on said first computer, said shopping list database includes other product information, wherein said other product information includes: a product description, a product cost, a date and time on which said product barcode was scanned and an indicator for a required quantity of said product (col.7 lines 13-20, fig.6 111);

(f) Obtaining in-hand said stored shopping list from said first computer in order to go to a first store and purchase products listed on said shopping list, said obtaining in-

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hand is selected from the group comprising: printing said stored shopping list on a printing device (see col.12 lines 23-26), transferring said stored shopping list to a portable computer device, and using said portable barcode scanner (see fig.1, shopping list via portable scanner displayed in a handheld device); and

(g) Sending said shopping list to an optional second store connected to said second network infrastructure, said second store shipping products listed on said shopping list to said consumer (col.6 lines 1-19); and

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(h) Sending said shopping list to an optional second store connected to said second network infrastructure, said second store <sup>making</sup> ~~making~~ said products listed on said shopping list available to said consumer for pick up (col.6 lines 1-19 customer goes to check out).

As per claim 15, Ruppert teaches a portable barcode scanner of claim 14, wherein said first network infrastructure is a wireless link (see col.6 lines 1-7).

As per claim 17, Ruppert teaches a portable barcode scanner of claim 14, wherein said first network infrastructure is a wired link between said portable barcode scanner and said first computer (see col.6 1-10).

As per claim 18, Ruppert teaches a portable barcode scanner of claim 17, wherein said wired link is selected from the group comprising: an RS-232 link, a USB link, a parallel link and an IEEE 1394 link (see col.6 lines 1-5).

As per claim 19, Ruppert teaches a first computer of claim 14 is selected from the group comprising: a personal computer, a personal digital assistant, an internet appliance, and a cell phone (see col.6 lines 1-5 and fig. 1).

As per claim 34, Ruppert teaches said portable computer device of claim 14 is selected from the group consisting: a personal digital assistant and a cell phone (see col.6 lines 1-5).

As per claim 35, Rupert teaches a shopping list of claim 14 is selected from the group comprising: beauty aids, books, clothing, computer hardware, computer software, computer supplies, drugs, footwear, groceries, gifts, health aids and music (see fig.1 shopping list).

As per claims 36-37, 39-41, and 43-44, the limitations of claims 36-37, 39-41, and 43-44, are similar to the limitations of claims 14-15, 17-19, and 34-35, therefore the are rejected under the same rationale.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 16, 20, 38 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruppert et al.

As per claims 16 and 38, Ruppert et al disclose a system and method for creating a shopping list and purchasing items from the list comprising a personal digital assistant (Fig. 1) including a data system (40 and 43) for receiving product identification data from a UPC selected by a consumer for inquiry (see col. 6, lines 49-55), and a data communication system (85) for communicating data on a network infrastructure to a



merchant computer system, wherein the merchant computer system includes a database that stores product descriptive information (see col. 6, lines 19-38). Ruppert et al further disclose a display (see Fig. 1) for displaying information associated with the product identifier. Ruppert et al further teach the steps of shopping in a store's aisles and delivering the items to the customers shopping basket (see Fig. 5, and columns 8 and 9).

Ruppert et al do not disclose a second network that interfaces with the portable interface unit through the Internet. However, it is common in the art to connect a personal digital assistant to a personal computer through a LAN, wherein the computer is connected to other computer systems through the Internet. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a personal computer as an intermediary with the invention of Ruppert et al to store information so that less memory is used in the personal digital assistant. Furthermore, use of the Internet is common in the art, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the Internet with the invention of Ruppert et al because the Internet is a convenient means of communication.

As per claim 20 and 42, Rupert discloses a wireless link selected from an infrared link (see col.6 lines 107).

Ruppert et al do not teach the step of communicating through a radio frequency channel on a Bluetooth radio frequency standard. However, radio communication is common in the art, as is the Bluetooth standard. It would have been obvious to one of

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ordinary skill in the art at the time the invention was made to employ a Bluetooth radio standard communication channel to allow for fast, wireless communication instead of cumbersome wired connections.

### ***Response to Arguments***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

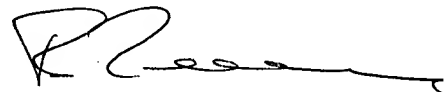
### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mussa A. Shaawat whose telephone number is 571-272-2945. The examiner can normally be reached on Mon-Fri (8am-5:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mussa Shaawat  
Patent Examiner  
April 16, 2007

 4/25/07  
F. Ryan Zeender  
SPE, A.U. 3627